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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,983	04/20/2001	David A. Hughes	SNY-P4339	1235

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MILLER PATENT SERVICES
2500 DOCKERY LANE
RALEIGH, NC 27606

EXAMINER

BATURAY, ALICIA

ART UNIT	PAPER NUMBER
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2155

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/21/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/838,983

Applicant(s)

HUGHES ET AL.

Examiner

Alicia Baturay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to the amendment filed 26 November 2004.
2. Claims 1, 9, 17, 24, 31, 36, and 42 were amended.
3. Claims 1-51 are pending in this Office Action.

Response to Amendment

4. The previous objections to the Drawings, Specification, and Claims have been addressed by Applicant and are withdrawn.
5. The terminal disclaimer filed on 26 November 2004 has been recorded and the double patenting rejection has been withdrawn.
6. Applicant's amendments and arguments with respect to claims 1-51 filed on 26 November 2004 have been fully considered but they are deemed to be moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 1, 2, 8-10, 17, 18, 24, 25, 32, 36, 37, 42, 43 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over "A guide to using MS Mail on PTOnet" (hereafter "Microsoft Mail") in view of Kelly (U.S. 6,442,595).

9. With respect to claim 1, Microsoft Mail teaches a method of transmitting an audio sample using electronic mail, comprising:

Within an email application program, providing a platform for a sender to generate an electronic mail message to a recipient; receiving a single command from the sender to attach a file (Microsoft Mail, page 13, top figure, note "Attach" button) and attaching the file (Microsoft Mail, page 13, top figure, note "Request.doc" file is attached).

Microsoft Mail does not explicitly teach a method of transmitting audio samples using electronic mail.

Microsoft Mail does not explicitly teach the use of a default audio sample.

However, Kelly teaches automatically attaching a file to a mail message (Kelly, col. 5, lines 12-19) where that file can be audio (Kelly, col. 6, lines 38-41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Microsoft Mail in view of Kelly in order to enable the use of a default audio sample. One would be motivated to do so in order to facilitate the sending of email attachments (Kelly, col. 5, line 41-43).

10. With respect to claim 2, Microsoft Mail teaches the invention described in claim 1, including a method of transmitting an audio sample using electronic mail, comprising:

Within an email application program, providing a platform for a sender to generate an electronic mail message to a recipient; receiving a single command from the sender to attach a file (Microsoft Mail, page 13, top figure, note "Attach" button) and attaching the file (Microsoft Mail, page 13, top figure, note "Request.doc" file is attached).

Microsoft Mail does not explicitly teach a method of transmitting audio samples using electronic mail.

However, Kelly teaches the method wherein the audio sample comprises a computer file containing a compressed audio sample (Kelly, col. 5, lines 41-43).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Microsoft Mail in view of Kelly in order to enable the use of a default audio sample. One would be motivated to do so in order to facilitate the sending of email attachments (Kelly, col. 5, line 41-43).

11. With respect to claim 8, Microsoft Mail teaches the invention described in claim 1, including wherein the single command comprises clicking an icon (Microsoft Mail, page 13, top figure).

12. With respect to claim 9, Microsoft Mail teaches a method of transmitting an audio sample using electronic mail comprising:

Within an email application program, providing a platform for a sender to generate an electronic mail message to a recipient (Microsoft Mail, page 13, top figure, note "Attach" button); receiving a command from the sender to send the electronic mail message; and

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sending the electronic mail message along with the audio sample to the recipient (Microsoft Mail, page 13, top figure, note "Send" button). Forwarding a message is a standard feature within most email programs. Additionally, when one chooses to forward a previously created email message that includes attachments, those attachments are already attached to this new email.

Microsoft Mail does not explicitly disclose automatically attaching an audio sample to an email.

However, Kelly teaches automatically attaching an audio sample (Kelly, col. 5, lines 12-19) to each electronic mail message generated by the sender (Kelly, col. 5, lines 12-19).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Microsoft Mail in view Kelly in order to enable automatically attaching an audio sample to an email. One would be motivated to do so in order to facilitate the sending of email attachments (Kelly, col. 5, line 41-43).

13. With respect to claim 24, Microsoft Mail teaches the invention described in claim 1, including an electronic mail system, comprising:

A programmed processor; an electronic mail application running on the programmed processor, the electronic mail application having a user interface including a plurality of user controls to permit a sender to create and send an electronic mail message to a recipient (Microsoft Mail, page 13, top figure).

Microsoft Mail does not explicitly teach attaching a default audio sample.

However, Kelly teaches program means forming part of the electronic mail application (Kelly, col. 5, lines 12-19), for attaching a default audio sample to all electronic mail documents (Kelly, col. 6, lines 38-41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Microsoft Mail in view of Kelly in order to enable the use of a default audio sample. One would be motivated to do so in order to facilitate the sending of email attachments (Kelly, col. 5, line 41-43).

14. Claims 10, 17, 18, 25, 32, 36, 37, 42, 43 and 48 do not teach or define any new limitations above claims 1, 2, 8, 9 and 24 and therefore are rejected for similar reasons.

15. Claims 3, 5, 6, 11, 13, 14, 16, 19, 21, 22, 26, 28, 29, 31, 33-35, 38-40, 44-47 and 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Mail in view of Kelly and in further view of Fritsch (U.S. 6,233,682).

16. With respect to claim 3, Microsoft Mail teaches the invention described in claim 2, including a method of transmitting an audio sample using electronic mail, comprising:

Within an email application program, providing a platform for a sender to generate an electronic mail message to a recipient; receiving a single command from the sender to attach a file (Microsoft Mail, page 13, top figure, note "Attach" button) and attaching the file (Microsoft Mail, page 13, top figure, note "Request.doc" file is attached).

Microsoft Mail does not explicitly teach a method of transmitting audio samples using electronic mail.

However, Kelly teaches the method wherein the audio sample comprises a computer file containing a compressed audio sample (Kelly, col. 5, lines 41-43).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Microsoft Mail in view of Kelly in order to enable the use of a default audio sample. One would be motivated to do so in order to facilitate the sending of email attachments (Kelly, col. 5, line 41-43).

The combination of Microsoft Mail and Kelly does not explicitly teach the audio sample comprising a link to a source for purchase.

However, Fritsch teaches the method wherein the audio sample further comprises a link to a source for purchase of a product containing a representation of the audio sample (Fritsch, col. 4, lines 58-60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Microsoft Mail and Kelly in view of Fritsch in order to enable the audio sample comprising a link to a source for purchase. One would be motivated to do so in order to facilitate the purchase of music online resulting in increased revenue via e-commerce (Fritsch, col. 1, lines 24-26).

17. With respect to claim 5, Microsoft Mail teaches the invention described in claim 1, including a method of transmitting an audio sample using electronic mail, comprising:

Within an email application program, providing a platform for a sender to generate an electronic mail message to a recipient; receiving a single command from the sender to attach a file (Microsoft Mail, page 13, top figure, note “Attach” button) and attaching the file (Microsoft Mail, page 13, top figure, note “Request.doc” file is attached).

Microsoft Mail does not explicitly teach a method of transmitting audio samples using electronic mail.

Microsoft Mail does not explicitly teach the use of a default audio sample.

However, Kelly teaches automatically attaching a file to a mail message (Kelly, col. 5, lines 12-19) where that file can be audio (Kelly, col. 6, lines 38-41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Microsoft Mail in view of Kelly in order to enable the use of a default audio sample. One would be motivated to do so in order to facilitate the sending of email attachments (Kelly, col. 5, line 41-43).

The combination of Microsoft Mail and Kelly does not explicitly teach the audio sample comprising a link to streaming music.

However, Fritsch teaches the method wherein the audio sample comprises a link to a source of streaming music (Fritsch, col. 4, lines 49-58). Figure 1C shows a user “pre-listening” to a song on a web page; it is inherent the music is streaming.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Microsoft Mail and Kelly in view of Fritsch in order to enable the audio sample comprising a link to streaming music. One would be motivated to

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do so in order to facilitate the purchase of music online resulting in increased revenue via e-commerce (Fritsch, col. 1, lines 24-26).

18. With respect to claim 16, Microsoft Mail teaches the invention described in claim 9, including the method of transmitting an audio sample using electronic mail, comprising:

Within an email application program, providing a platform for a sender to generate an electronic mail message to a recipient; receiving a single command from the sender to attach a file (Microsoft Mail, page 13, top figure, note "Attach" button) and attaching the file (Microsoft Mail, page 13, top figure, note "Request.doc" file is attached).

Microsoft Mail does not explicitly teach a method of transmitting audio samples using electronic mail.

Microsoft Mail does not explicitly teach the use of a default audio sample.

However, Kelly teaches automatically attaching a file to a mail message (Kelly, col. 5, lines 12-19) where that file can be audio (Kelly, col. 6, lines 38-41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Microsoft Mail in view of Kelly in order to enable the use of a default audio sample. One would be motivated to do so in order to facilitate the sending of email attachments (Kelly, col. 5, line 41-43).

The combination of Microsoft Mail and Kelly does not explicitly indicate that a server is being used to distribute the emails.

However, Fritsch teaches the method wherein the automatically attaching takes place in an enterprise electronic mail server (Fritsch, col. 3, lines 4-13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Microsoft Mail and Kelly in view of Fritsch in order to enable the audio sample comprising a link to streaming music. One would be motivated to do so in order to facilitate the purchase of music online resulting in increased revenue via e-commerce (Fritsch, col. 1, lines 24-26).

19. With respect to claim 31, Microsoft Mail teaches an electronic mail system, comprising:

A computer network; a programmed processor forming part of the computer network; an electronic mail application running on the programmed processor, the electronic mail application having a user interface including a plurality of user controls to permit a sender to create and send an electronic mail message to a recipient (Microsoft Mail, page 13, top figure).

Microsoft Mail does not explicitly teach the use of an audio sample.

However, Kelly teaches automatically attaching a file to a mail message (Kelly, col. 5, lines 12-19) where that file can be audio (Kelly, col. 6, lines 38-41).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Microsoft Mail in view of Kelly in order to enable the use of an audio sample. One would be motivated to do so in order to facilitate the sending of email attachments (Kelly, col. 5, line 41-43).

The combination of Microsoft Mail and Kelly does not explicitly teach an enterprise email server or a means on the mail server to attach a file to an outbound email.

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However, Fritsch An enterprise email server forming a part of the computer network, wherein email messages created using the electronic mail application are passed through the email server; and program means, running on the enterprise mail server, for attaching an audio sample to an electronic mail document sent from the electronic mail application to the recipient (Fritsch, col. 3, lines 4-13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Microsoft Mail and Kelly in view of Fritsch in order to enable the use of an enterprise email server or a means on the mail server to attach a file to an outbound email. One would be motivated to do so in order to facilitate the purchase of music online resulting in increased revenue via e-commerce (Fritsch, col. 1, lines 24-26).

20. Claims 6, 11, 13, 14, 19, 21, 22, 26, 28, 29, 33-35, 38-40, 44-47 and 49-51 do not teach or define any new limitations above claims 3, 5, 16 and 31 and therefore are rejected for similar reasons.

21. Claims 4, 7, 12, 15, 20, 23, 27 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Mail in view of Kelly in view of Fritsch and in further view of Kang (U.S. 2001/0051925).

22. With respect to claim 4, Microsoft Mail teaches the invention described in claim 3, including a method of transmitting an audio sample using electronic mail, comprising:

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Within an email application program, providing a platform for a sender to generate an electronic mail message to a recipient; receiving a single command from the sender to attach a file (Microsoft Mail, page 13, top figure, note "Attach" button) and attaching the file (Microsoft Mail, page 13, top figure, note "Request.doc" file is attached).

Microsoft Mail does not explicitly teach a method of transmitting audio samples using electronic mail.

However, Kelly teaches the method wherein the audio sample comprises a computer file containing a compressed audio sample (Kelly, col. 5, lines 41-43).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Microsoft Mail in view of Kelly in order to enable the use of a default audio sample. One would be motivated to do so in order to facilitate the sending of email attachments (Kelly, col. 5, line 41-43).

The combination of Microsoft Mail and Kelly does not explicitly teach the audio sample comprising a link to a source for purchase.

However, Fritsch teaches the method wherein the audio sample further comprises a link to a source for purchase of a product containing a representation of the audio sample (Fritsch, col. 4, lines 58-60).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Microsoft Mail and Kelly in view of Fritsch in order to enable the audio sample comprising a link to a source for purchase. One would be motivated to do so in order to facilitate the purchase of music online resulting in increased revenue via e-commerce (Fritsch, col. 1, lines 24-26).

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The combination of Microsoft Mail, Kelly and Fritsch does not explicitly teach the use of affinity credit.

However, Kang teaches the method wherein if the recipient makes a purchase from the source, an affinity credit is awarded to the sender (Kang, paragraphs 29-30).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Microsoft Mail, Kelly and Fritsch in view of Kang in order to enable the use of affinity credit. One would be motivated to do so in order to encourage the wide distribution and purchase of content (Kang, paragraph 29).

23. Claims 7, 12, 15, 20, 23, 27 and 30 do not teach or define any new limitations above claim 4 and therefore are rejected for similar reasons.

Response to Arguments

24. ***Applicant Argues:*** Applicant states that claims have “been amended to clarify that the attachment of the predefined audio sample is a “default” audio sample...The original terminology was intended to embrace this, but upon review the undersigned feels that use of the term “default” may be more descriptive, without affecting the scope of the claim...Neither reference reasonably teaches or suggests a single click actuation of attachment of a default music clip attachment.”

In response: Examiner appreciates the clarification of claims with respect to the use of the term “default.” However, Examiner respectfully submits that this does change the scope of the claims. Using the broadest reasonable interpretation, the phrase “predefined audio sample” could be taken to mean that the sample was created before the act of attaching it to an electronic mail message. The inclusion of the word “default” and Applicant’s accompanying explanation necessitate a new ground of rejection. This new reference also teaches a single click actuation of an attachment.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Baturay whose telephone number is (571) 272-3981. The examiner can normally be reached at 7:30am - 5pm, Monday - Thursday, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alicia Baturay
December 11, 2006


SALEH NAJJAR
SUPERVISORY PATENT EXAMINER